

REMARKS

Claims 1-15 are present.

Claims 1-15 are rejected.

Rejections Under 35 USC 103(a)

Claims 1-15 are rejected under 35 USC 103(a) as being unpatentable over Lee et al. (W/O 2004/032566A1) in view of Applicant's admission. Claims 1, 2 and 7 have been amended to more particularly point out the applicant's invention. Claims 1 and 7 are directed toward a portable telephone having a concave portion larger than a bone conduction device that is positioned therein where a cushioning material is attached to the edge and a gap is formed continuously between the concave portion of the housing and the bone conduction device and positions the vibration surface of the bone conduction device away from the housing. Claim 2 is directed toward a through-hole mounted bone conduction device attached at the edges.

The Lee '566 publication teaches a bone conduction device positioned **in contact** with a concave portion of the housing as stated at p18, ln 10-12 stating that "*the bone conduction speaker 80 is provided at the inner side of the upper end portion of the cover 86 of the mobile phone.*" The Lee '566 publication is silent or does not teach either a gap between the bone conduction device and the housing of the portable phone as required by the applicant's claims. The Lee '566 publication shows the bone conduction device in the figures contacting the walls of the concave portion of the housing. Furthermore, the applicant's alleged prior art admission of FIGs 10 and FIG. 11 **does not show or disclose a gap between the bone conduction device and the concave portion,** but shows a resilient material positioned there between **removing** the gap.

Regarding claims 5 and 10-12 directed toward a rotatable type phone and 6, 13-15 directed toward a slidable phone the Examiner cites “OFFICIAL NOTICE” that the portable telephone could be either a slidable or rotatable type. The applicant rejects that a rotatable or slidable bone conduction speaker type of phone that when close has the second portion in contact with the speaker is well known in the art. The rejection is instead based on the Examiner’s personal knowledge based upon IMPROPER hindsight reasoning based upon the applicant’s own specification and an inability to find references that teaches each and every element of the rejected claims 5-6 and 10-15.

The Applicants respectfully requests removal of the improper “OFFICIAL NOTICE” rejection from claims 5-6 and 10-15, which either should be allowed for failing to form a prime facie case of obviousness or replaced with either a proper reference teaching a combination of ALL elements or the Examiner’s declaration to their personal knowledge of a rotatable or slidable bone conduction phones as claimed by the applicant for rebuttal as is required by the MPEP. The MPEP states that It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known **are not capable of instant and unquestionable demonstration as being well-known**. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979)

Claims 1, 4-6, 10 and 13 as amended claims a bone conduction device attached at the edge forming a gap between the device and the concave portion. The rejection of claims 1, 4-6,

10 and 13 as amended is improper because the combination of references fails to teach each and every element of the obviousness rejection, which the applicant respectfully requests reconsideration and removal of the rejection.

Claims 2-3, 11-12 and 14-15 all are directed toward a phone including a through-hole portion, which means a hole through both panels of the phone. The Lee '566 publication DOES NOT teach or disclose a through-hole portion where the bone conduction device is mounted in the housing of the portable phone as required by the applicant's claims. Furthermore, the Examiner's recitation of the **applicant's alleged admission of FIG. 10 and FIG. 11 are directed toward a concave portion and NOT a through-hole portion.** The Lee '566 publication shows the bone conduction device contacting the walls of the concave portion of the housing and is silent regarding the through-hole. One skilled in the art would not be motivated by applicant's alleged admission of FIGs 10 and FIG. 11 either alone or in combination with the Lee '566 publication to produce the claimed invention.

Regarding claim 3, the applicant's alleged admission does not teach a through-hole. The Lee reference does not teach a through-hole and is silent regarding a vibration surface on the opposite side. The examiner alleges that Lee, page 10 lines 23-25, page 11 lines 1-5, page 11 lines 9-17 are relevant to the applicant's claimed invention. An irrelevant passage of Lee's teaching with respect to the claims at page 10 lines 23-25 providing: *"A mastoid 18 which is made of plastic material is formed on the upper portion of the body 10. The lower diameter of the mastoid is smaller than its upper diameter thereof."* A further cited irrelevant passage of Lee's teaching with respect to the claims at page 11 lines 1-5 provides: *"under the mastoid 18 and engaged into the first groove 12 of the upper portion of the body 10 to cover the top of the body*

10. *The vibrating plate 22 is made of beryllium copper having a certain elastic force. The auxiliary vibrating plate 24 is formed to be inserted to the lower portion of the mastoid 18 under the vibrating plate 22.*” A further cited irrelevant passage of Lee’s teaching with respect to the claims at page 11 lines 9-17 provides: *“In the mastoid 18 and the auxiliary vibrating plate 24, howling preventing holes 20 and 26 are formed to prevent the howling effect at ears of the user, respectively. The mastoid 18, the vibrating plate 22, and the auxiliary vibrating plate 24 are engaged by a pressure inserting method. In particular, an ultrasonic vibration attachment and a reinforcement attachment by using an adhesive are carried out on the contacting portions of the mastoid 18, the vibrating plate 22, and the auxiliary vibrating plate 24. And then, a drying process is carried out on the contacting portions for 4 hours.”* None of the cited passages are relevant to the applicant’s claim 3.

Claims 2-3, 11-12 and 14-15 as amended claims a bone conduction device attached at the edge of the device in the through-hole portion. The rejection of claims 2-3, 11-12 and 14-15 as amended is improper because the combination of references fails to teach each and every element of the obviousness rejection, which the applicant respectfully requests reconsideration and removal of the obviousness rejections.

CONCLUSION

Favorable action constituting allowance of claims 1-15 is solicited. A one-month extension of time is required and may be charged to deposit account 19-0153 or any additional required extension fees. The applicant requests that the Examiner contacts our office if there are any questions or to advance the application to allowance.

Respectfully submitted,

Date: 15JAN08

/Jeffrey D. Washville/
Jeffrey D. Washville
Reg. No. 46,366

SCHMEISER, OLSEN & WATTS
22 Century Hill Drive, Suite 302
Latham, N.Y. 12110
(518) 220-1850